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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,995	11/18/2005	Kiyoshi Yagi	Q87740	9113
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EXAMINER				
RONESL VICKEY M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,995

Applicant(s)

YAGI ET AL.

Examiner

Vickey Ronesi

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 11/24/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of objections rejection set forth below are necessitated by applicant's amendment filed on 11/24/2008. In particular, claim 1 has been amended to mandatorily include magnesium hydroxide, which heretofore had been in an alternative embodiment. Thus, the following action is properly made final.

Claim Objections

4. Claim 1 is objected to because the term "comprising" should be replaced with "comprises" to be grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570, full English-language translation) in view of Sham et al (US 5,256,719).

JP '570 discloses a resin composition comprising a polyolefin-polyamide resin composition that is mixed with rubber or resin as reinforcement (paragraph 0001), wherein the polyolefin-polyamide resin composition comprises 90-40 parts by weight (pbw) polyolefin, 10-60 pbw polyamide fibers having an average fiber diameter of 1 micron or less and an aspect ratio of 20-1,000, and 0.1-5.5 pbw per 100 pbw, per total of polyolefin and polyamide, silane coupling

agent (abstract). Note Table 2 which has the polyolefin-polyamide resin composition mixed with NBR (nitrile butadiene rubber) or PE (polyethylene).

JP '527 fails to disclose the use of magnesium hydroxide in the composition, however, it is open to the use of other additives such as fillers (paragraph 0025).

Sham et al discloses a flame retardant plastics composition comprising polyolefin and polyamide (like JP '570) and uses magnesium hydroxide to impart flame retardance to the composition (abstract). Sham et al further teaches that magnesium hydroxide is successfully added to the plastic because the polyamide facilitates magnesium hydroxide dispersion (col. 2, lines 26-30).

Given that JP '527 is open to the use of additives and further given that Sham et al teaches that magnesium hydroxide is advantageously and successfully added to polyolefin/polyolefin compositions in order to impart flame retardance, it would have been obvious to one of ordinary skill in the art to add magnesium hydroxide to the composition of JP '570.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570, full English-language translation) in view of Sham et al (US 5,256,719) and further in view of JP '464 (JP 11-302464).

The discussion with respect to JP '570 and Sham et al in paragraph 5 above is incorporated here by reference.

JP '570 discloses the use of a filler such as "white carbon," but fails to exemplify or teach the use of silica.

Sugiyama et al teaches that silica is also known as "white carbon" (col. 2, lines 26-27).

Given that JP '570 teaches the use of a white carbon filler which is equivalent to silica as taught by Sugiyama et al, it would have been obvious to one of ordinary skill in the art utilize silica in the polyolefin-polyamide resin composition taught by JP '570.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570, full English-language translation) in view of Sham et al (US 5,256,719) and further in view of JP '464 (JP 11-302464).

The discussion with respect to JP '570 and Sham et al in paragraph 5 above is incorporated here by reference.

JP '570 fails to disclose the use of its polyolefin-polyamide resin composition in a composition for a sheath in an electric wire.

JP '464 discloses a composition comprising polyethylene, polyamide fibers, and a silane coupling agent for use in electric wires.

Given that JP '570 discloses a composition comprising polyethylene, polyamide fibers, and a silane coupling agent that is further mixed with polyethylene and further given that JP '464 teaches that a composition comprising those ingredients are suitable for use in electric wires, it would have been obvious to one of ordinary skill in the art to utilize the composition of JP '570 in an electric wire.

Double Patenting

Double Patenting, I

8. The terminal disclaimer filed on 11/24/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent no. 7,041,726 has been reviewed and is accepted. The terminal disclaimer has been recorded and the obviousness-type double patenting rejection has been withdrawn.

Double Patenting, II

9. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of copending Application No. 10/553159 (published as US 2006/0241221).

US appl. '159 claims a polyolefin resin composition comprising polyolefin and polyamide ultrafine fibers-dispersed polyolefin resin composition comprising silica particles in a ratio of polyolefin to polyamide of 1:1 to 9:1.

US appl. '159 fails to claim a magnesium hydroxide, however, the claims of US appl. '159 due to open claim language "comprises" and page 20 of the specification of US appl. '159 teaches that magnesium hydroxide can be added. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970). Therefore, it would have been obvious to one of ordinary skill in the art to add magnesium hydroxide to the claims of US appl. '159.

10. Claims 1-4 are directed to an invention not patentably distinct from claims 4 and 5 of commonly assigned copending Application No. 10/533,159 (published as US 2006/0241221). Specifically, see the discussion set forth in paragraph 9 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 10/533,159 (published as US 2006/0241221), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004. It is suggested that applicant submit a statement such as, "Application X and Application Y were, at the time the invention of Application X was made, owned by Company Z." See MPEP § 706.02(l)(2).

Response to Arguments

11. Applicant's arguments filed 11/24/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that JP '570 fails to disclose magnesium hydroxide.

In response, the examiners, however, this is precisely why new reference Sham et al has been introduced in the above grounds of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/6/2009
vr

/Vickey Ronesi/
Examiner, Art Unit 1796